

REMARKS

This paper responds to the office action mailed on April 27, 2010. Pending claims 1, 13-14, 17-22, 35-39, 64 and 67-80 stand rejected. These rejections are traversed. Reconsideration is respectfully requested in view of the following remarks.

Claim Rejections – 35 U.S.C. §112

The Office Action rejects all 29 of the pending claims as failing to comply with the enablement requirement of 35 U.S.C. §112. This rejection is clearly improper for several reasons. First, the rejection makes absolutely no attempt to address the actual language of the claims, and thus wholly fails to establish a proper rejection. Rather, the Office Action rejects all 29 claims by stating only that:

Applicant's specification does not provide details as to how one of ordinary skill would implement the computer-implemented aspects of Applicant's invention (i.e. no computer code or programming comments are provided) to "determine the number of hits, hyperlinks, sales" and "charge for advertising" based on the number of hits, hyperlinks and sales. In fact the specification lacks, [sic] any details of Applicant's implementation.

Notably, the above rejection does not even recite a single element of any of the 29 pending claims. The Applicant cannot reasonably be expected to respond to this type of incomplete rejection. For example, what claim elements does the Examiner contend are not enabled? Is the Examiner suggesting that the specification is insufficient to enable the person of ordinary skill in the art to create any of the "computer-implemented" elements of all 29 claims? Claim 1 and its dependent claims, for instance, recite a "computer-implemented" method. As it stands, the rejection under 35 U.S.C. §112 suggests that not even a single element of any of these "computer-implemented" method claims could be created by a programmer of reasonable skill in the art based on the disclosure set forth in the specification. Although it seems unlikely that this could be the Examiner's intent, without a more detailed rejection, sufficient to establish a *prime*

facie rejection under 35 U.S.C. §112, the Applicant is left to assume that the Examiner contends that the specification is insufficient to enable any computer-implemented claim element. This conclusion is simply not supported by the facts or by relevant Federal Circuit precedent regarding enablement.

The conclusion of the Office Action is unsupported by the facts because the specification clearly does provide adequate support for a programmer of reasonable skill in the art to write a program to implement each of the “computer-implemented” steps or functions of the pending claims. For instance, the disclosure at page 14, line 16 through page 15, line 6 of the specification describes a specific way of tracking access history within a client-server session, for instance providing enabling support for the method recited in claim 1. Additional support is provided, for example, at page 7, lines 17-20, page 9, lines 13-15, page 12, lines 18-26 and page 14, lines 7-13. Unquestionably, this description is more than sufficient to enable a programmer of ordinary skill to write a program that embodies the method recited in claim 1 and other claims having “computer-implemented” steps or functions.

Further, to the extent that the enablement rejections presented by the Office Action contend that the Applicant is required to provide “computer code or programming comments” in order to satisfy the requirements of 35 U.S.C. §112, the rejections are unsupported by the prevailing Federal Circuit precedent, as explained in detail in the Pre-Appeal Request for Review filed by the Applicants in response to the previous Office Action.

For at least these reasons, the Applicant submits that the rejections under 35 U.S.C. §112 are improper and must be withdrawn.

Claim Rejections – 35 U.S.C. §103

The pending claims are also each rejected under 35 U.S.C. §103 as being unpatentable over Ferguson (U.S. Pat. No. 5,819,092). The Applicant respectfully submits that these rejections are overcome by the Rule 131 Affidavit filed on January 29, 2007, and that the rejections must therefore be withdrawn.

In a previous Office Action, mailed on January 10, 2008, the Examiner contended that the Rule 131 Affidavit was insufficient to swear behind the Ferguson reference (then cited as an anticipating reference under 34 U.S.C. §102(e)), alleging that the Ferguson reference claims the same invention as the instant application. However, the January 10 Office Action only attempted to demonstrate this alleged correspondence between Ferguson's claims and *one claim* of the sixty-three claims that were then pending in the application – claim 41. Claim 41 has since been cancelled, and the Examiner has provided *no evidence* that any other claim corresponds with claims of the Ferguson reference. Without such evidence, the PTO cannot maintain that the Affidavit under 37 C.F.R. §1.131 is “ineffective” with respect to the remaining claims of this application.

Further, the Applicant submits that the Examiner *cannot* provide proper evidence that the pending claims correspond with claims of the Ferguson reference because the claims are clearly distinct. This is evidenced by the fact that the Examiner now makes a §103 rejection over Ferguson, acknowledging that all of the claimed elements are not expressly disclosed (let alone claimed) by Ferguson. For at least these reasons, the Applicant respectfully submits that the rejections over Ferguson are overcome by the Rule 131 Affidavit and must be withdrawn.

Conclusion

For at least the above-stated reasons, the Applicant respectfully submits that the pending claims are patentable over the cited references and are in condition for allowance.

Respectfully submitted,

By: 

David B. Cochran

Reg. No. 39,142

JONES DAY

901 Lakeside Avenue

Cleveland, Ohio 44114

(216) 586-7029